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#### D. REMARKS

##### *Specification*

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

In addition, Applicants have amended the specification to overcome the informality in the abstract, line 12 by canceling "feasiblely" and adding "feasibly".

##### *Interview Summary*

On November 29, 2004 at 2 PM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Rosen. No exhibits were shown, nor demonstrations conducted.

First, Applicants' representative and Examiner Rosen discussed claims 1 and 33, and in particular the rejection of claims 1 and 33 under 35 USC 101. Applicants' representative proposed amendments to claims 1 and 33 to overcome the 101 rejection. Examiner Rosen suggested amending the claims to include the limitation of "processing, by a computer system..." rather than "processing, at a computer system...". Applicants' representative has amended claims 1 and 33 to reflect the Examiner's suggestion.

Second, Applicants' representative and Examiner Rosen discussed a clarification of "whether the Examiner interprets "feasibility responses" to include bids made by manufacturers bidding in an auction system described in Gillman." The Examiner explained that the bids in Gillman teach "feasibility responses" because the bids include additional information from the manufacturer and include questions asked by the manufacturer. The Examiner noted that paragraph 41 describes a bid including pricing and a delivery date, as well as additional information. In addition, the Examiner noted that paragraph 44 describes submitting more than one bid with different criteria for each bid.

No agreement was reached with respect to the claims. Applicant is filing this response for further review by the Examiner.

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### *Claim Objections*

#### **Claims 22-32**

The Examiner objects to claims 22-32 because of the following informality: "Claim 22 could be interpreted as reciting a computer program per se, which is not patentable. Claim 22 recites a computer usable medium having computer readable program code means, but it is not clear what "means" means, and on a literal reading of the claim language, the claim would read on a program for procuring a manufacturer-if that program resides on a computer-usable medium, and the medium has other computer readable program code means, even if the "program for procuring a manufacturer" is a list of instructions and recommendations for a human being to carry out. Furthermore, the program is described as comprising "means for", which reads more like computer hardware." [Office Action, p. 2] The Examiner suggests correction in the following format: "A computer program for procuring a manufacturer, said program embodied in a computer-readable medium, said program comprising computer-executable instructions which cause a computer to perform: the step of transmitting...; the step of receiving...; and the step of enabling response..." [Office Action, p. 2-3] Applicants note that claims 22-32 are amended to correct the informality, reflecting the suggested correction by the Examiner. For example, claim 22 now reads as follows:

22.(Currently Amended) A computer program for procuring a manufacturer, said program embodied in a computer-readable medium, said program comprising computer-executable instructions which cause a computer to perform the steps of ~~residing on a computer usable medium having computer readable program code means, said program comprising:~~

~~means for~~ transmitting a specialized project request for a buyer to at least one manufacturer broker;

responsive to said at least one manufacturer broker identifying one from among a plurality of current project requests filed with said at least one manufacturer broker that matches said specialized project request, receiving a

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notification for said buyer of said one of said plurality of current project requests that matches said specialized project request;

responsive to receiving a selection by said buyer of said one of said plurality of current project requests, enabling submission of said selection to said at least one manufacturer broker, wherein said at least one manufacturer broker facilitates specialization of said one of said plurality of current project requests by said buyer;

responsive to said at least one manufacturer broker not matching said specialized project request with said one from among said plurality of current project requests, means for receiving a plurality of feasibility responses for manufacture of said project request from a plurality of prospective manufacturers via said at least one manufacturer broker; and

means for enabling a response to said plurality of feasibility responses by selecting a manufacturer from among said plurality of prospective manufacturers, such that said buyer procures said manufacturer from among said plurality of prospective manufacturers utilizing a single project request.

#### **Claims 52-61**

Further, the Examiner objects to claims 52-61 for the same informality as discussed with reference to claims 22-32. [Office Action, p. 3] Applicants note that claims 52-61 are also amended to correct the informality, reflecting the suggested correction by the Examiner.

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PATENT  
09/875,864**Claims 39, 48, and 58**

The Examiner objects to claims 39, 48, and 58 because of the following informality: "In each of these claims, "said feasibility responses...for said adjusted project" lacks antecedent basis." [Office Action, p. 3] Applicants note that claims 39, 48, and 58 are amended to correct the informality. In particular, "said feasibility responses" is amended to read "a plurality of adjusted project request feasibility responses".

**Claims 42, 51, and 61**

The Examiner objects to claims 42, 51, and 61 because of the following informality: "In each of these claims, "said preferred manufacturer" lacks antecedent basis." [Office Action, p. 3] Applicants note that claims 42, 51, and 61 are amended to correct the informality. In particular, "said preferred manufacturer" is amended to read "a selection of a preferred manufacturer from among said selection of prospective manufacturers".

***35 USC § 101*****Claims 1-11**

The Examiner rejects claims 1-11 under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. In articulating the rejection, the Examiner states that "the claims are directed to a method not within the technological arts... The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452)." [Office Action, pp. 3-4] In particular, the Examiner states that "procuring a manufacturer for a project request may be useful, but is not concrete or tangible." [Office Action, p. 4] Further, the Examiner notes that "claim 2 recites use of a client connected through a network to a broker server system, but this is held to be a trivial use of technology, insufficient to toll the statute." [Office Action, p. 4]

Claims 1 currently reads:

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1. (Currently Amended) A method for procuring a manufacturer for a project request comprising the steps of:

submitting a specialized project request for a buyer to at least one manufacturer broker;

responsive to said at least one manufacturer broker identifying one from among a plurality of current project requests filed with said at least one manufacturer broker that matches said specialized project request, receiving a notification for said buyer of said one of said plurality of current project requests that matches said specialized project request;

responsive to receiving a selection by said buyer of said one of said plurality of current project requests, submitting said selection to said at least one manufacturer broker, wherein said at least one manufacturer broker facilitates specialization of said one of said plurality of current project requests by said buyer;

responsive to said at least one manufacturer broker not matching said specialized project request with said one from among said plurality of current project requests, receiving a plurality of feasibility responses for manufacture of said project request from a plurality of prospective manufacturers via said at least one manufacturer broker; and

processing, by a computer system, said plurality of feasibility responses so as to select responding to said plurality of feasibility responses by selecting a manufacturer from among said plurality of prospective manufacturers, such that said buyer procures said manufacturer from among said plurality of prospective manufacturers utilizing a single project request.

As indicated the last element now reads: "processing, by at least one computer, said plurality of feasibility responses so as to select a manufacturer from among said plurality of prospective manufacturers". In particular, Applicants have amended claim 1 by using the

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“processing, by at least one computer, *data* so as to *perform X...*” format. In a previous interview, regarding a related pending patent application 09/876,057, the Examiner suggested a similar format for amending claims to place the claims within the technological arts. Thus, Applicants respectfully request removal of the rejection under 35 USC 101 and allowance of amended claims 1-11, where independent claim 1 is amended towards allowance and claims 2-11 are dependent upon claim 1.

#### Claims 33-42

In addition, the Examiner rejects claims 33-42 under 35 USC 101 for the same reasons as given for the rejection of claims 1-11. In particular, the Examiner states that “procuring a manufacturer for a project may be useful, but is not concrete or tangible.” [Office Action, p. 4] Further, the Examiner notes that “claims 34 recites use of a broker server connected through a network to a plurality of client systems, but this is held to be a trivial use of technology, insufficient to toll the statute.” [Office Action, p. 5]

Claim 33 currently reads:

33.(**Currently Amended**) A method for brokering project requests among a plurality of available manufacturers, said method comprising the steps of:

receiving a project request from a buyer;

processing, by a computer system, said project request so as to compare said project request with a plurality of current project requests;

responsive to detecting that said project request matches one of said plurality of current project requests, notifying said buyer that said project request matches one of said plurality of current project requests;

responsive to receiving a buyer request for said one of said plurality of current project requests, facilitating said buyer in placing a specified order for said one of said plurality of current project requests;

responsive to not detecting a match between one of said plurality of current project requests, distributing said project request according to type of

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manufacture to a selection of prospective manufacturers from among a plurality of available manufacturers; and

in response to receiving a plurality of feasibility responses from said selection of prospective manufacturers, processing, by a computer system, said plurality of feasibility responses so as to facilitate [facilitating] a determination of the feasibility of manufacture of said project request according to said plurality of feasibility responses, such that said project request is brokered for said buyer to facilitate obtaining a manufacturer for said project request.

Claim 33 is amended in a similar manner as claim 1, to follow the “processing, by at least one computer, *data* so as to *perform X...*” format. Applicants respectfully assert that claim 33 is amended to fall with the technological arts and respectfully request allowance of amended claim 33. In addition, for the same reasons as allowance of claims 1-11 is requested, Applicants respectfully request removal of the rejection under 35 USC 101 and allowance of amended claims 33-42, where independent claim 42 is amended towards allowance and claims 43 and 44 are dependent upon claim 42.

### 35 USC § 102(e)

Claims 1, 2, 6, 12, 16, 33, 34, 36, 40, 41, 43, 45, 49, and 50 stand rejected under 35 U.S.C. §102(e) as being anticipated by Gillman. (US Patent Application Publication 2002/0147674) “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because amended Gillman does not teach each and every element of amended claims 1, 2, 6, 12, 16, 33, 34, 36, 40, 41, 43, 45, 49, and 50, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

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PATENT  
09/875,864**Claims 1, 2, and 6**

With respect to claim 1, the Examiner cites paragraphs 26, 27, 30, 38, 41, 42, 44, 45, 46, and 49 of Gillman as teaching the method of claim 1. In particular, the Examiner cites paragraphs 26, 27, and 30 as teaching the element of “submitting a personalized project request for a buyer to at least one manufacturer broker”, paragraphs 38, 41, 42, and 44 as teaching the element of “receiving a plurality of feasibility responses for manufacture of said project request from a plurality of prospective manufacturers via said at least one manufacturer broker”, and paragraphs 45, 46, and 49 as teaching the element of “responding to said plurality of feasibility responses by selecting a manufacturer from among said plurality of prospective manufacturers, such that said buyer procures said manufacturer from among said plurality of prospective manufacturers utilizing a single project request.” [Office Action, p. 5]

Applicants amend claim 1 to incorporate elements similar to those of claim 35, which is objected to by the Examiner. In particular, Applicants note that the Examiner objected to claim 35, which is dependent upon claim 33, as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to be clearly within the technological arts. [Office Action, p. 19] In particular, the Examiner notes that Gillman, the closest prior art of record, anticipates claim 33, but “does not disclose comparing the project request with a plurality of current project requests, etc.” [Office Action, p. 19]

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Claim 1 currently reads:

1. **(Currently Amended)** A method for procuring a manufacturer for a project request comprising the steps of:

submitting a specialized project request for a buyer to at least one manufacturer broker;

responsive to said at least one manufacturer broker identifying one from among a plurality of current project requests filed with said at least one manufacturer broker that matches said specialized project request, receiving a notification for said buyer of said one of said plurality of current project requests that matches said specialized project request;

responsive to receiving a selection by said buyer of said one of said plurality of current project requests, submitting said selection to said at least one manufacturer broker, wherein said at least one manufacturer broker facilitates specialization of said one of said plurality of current project requests by said buyer;

responsive to said at least one manufacturer broker not matching said specialized project request with said one from among said plurality of current project requests, receiving a plurality of feasibility responses for manufacture of said project request from a plurality of prospective manufacturers via said at least one manufacturer broker; and

processing, by a computer system, said plurality of feasibility responses so as to select ~~responding to said plurality of feasibility responses by selecting a~~ manufacturer from among said plurality of prospective manufacturers, such that said buyer procures said manufacturer from among said plurality of prospective manufacturers utilizing a single project request.

First, the elements of claim 35 are “comparing said project request with a plurality of current project requests”, “notifying said buyer if said project request matches one of said

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plurality of current project requests”, and “facilitating said buyer in placing a specified order for said one of said plurality of current project requests, in response to receiving a buyer request for said one of said plurality of current project requests.” Applicants respectfully propose that the amended elements of amended claim 1 are similar to the elements of claim 35, however are written from the perspective of submitting the project request, rather than the claim 35 perspective of receiving the project request. In particular, the amended elements of claim 1 that are similar to the elements of claim 35 are: “responsive to said at least one manufacturer broker identifying one from among a plurality of current project requests filed with said at least one manufacturer broker that matches said specialized project request, receiving a notification for said buyer of said one of said plurality of current project requests that matches said specialized project request” and “responsive to receiving a selection by said buyer of said one of said plurality of current project requests, submitting said selection to said at least one manufacturer broker, wherein said at least one manufacturer broker facilitates specialization of said one of said plurality of current project requests by said buyer.” While Applicants note that objected to claim 35 is dependent upon independent claim 35, and not independent claim 1, the Examiner rejects independent claims 1 and 33 based on the same teachings of Gillman. Thus, Applicants respectfully request allowance of amended claim 1, where amended to claim 1 is amended to incorporate the similar elements to those elements of objected to claim 35.

Second, Applicants respectfully assert that Gillman does not teach that a buyer will receive a notification that a specialized project request matches a project request already submitted to a manufacturer broker or that responsive to the buyer selecting the matching project request, the manufacturer broker will then facilitate the specialization of the matching project by the buyer. In contrast, amended claim 1 teaches “receiving a notification for said buyer of one of said plurality of current project requests that matches said specialized project request” and “responsive to receiving a selection by said buyer of said one of said plurality of current project requests, submitting said selection to said at least one manufacturer broker, wherein said at least one manufacturer broker.” Thus, Applicants respectfully request that because Gillman does not

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teach all the elements of amended claim 1, that the rejection be withdrawn, and the claim allowed.

With respect to claims 2 and 6, the Examiner rejects these claims as anticipated by Gillman. Applicants respectfully propose that because Gillman no longer anticipates independent claim 1, upon which dependent claims 2 and 6 rely, then Gillman also does not anticipate dependent claims 2 and 6 and dependent claims 2 and 6 should be allowed.

#### **Claims 12 and 16**

With respect to claim 12, the Examiner rejects claim 12 on similar grounds as the rejection of claim 1. [Office Action, p. 6] In particular, the Examiner cites paragraphs 23-27 and Figure 1 as teaching "a client computer system communicatively connected to a network", paragraphs 26, 27, and 30 as teaching the "means for submitting a personalized project request for a buyer from said client computer system to at least one manufacturer broker via said network", paragraphs 38, 41, 42, and 44 as teaching the "means for receiving a plurality of feasibility responses as compiled by said at least one manufacturer broker for manufacture of said project request from a plurality of prospective manufacturers via said network", and paragraphs 45, 46, and 49 as teaching the "means for responding to said plurality of feasibility responses by selecting a manufacturer from among said plurality of prospective manufacturers, such that said buyer procures said manufacturer from among said plurality of prospective manufacturers." [Office Action, p. 6]

Applicants amend claim 12 in the parallel manner to claim 1, which is amended to incorporate claim 35. In particular, as amended, Gillman does not teach all the elements of amended claim 12. Since amended claim 12 is closely parallel to amended claim 1, Applicants respectfully request allowance of amended claim 12 for the same reasons as amended claim 1 should be allowed.

With respect to claim 16, the Examiner rejects these claims as anticipated by Gillman. Applicants respectfully propose that because Gillman no longer anticipates independent claim

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12, upon which dependent claim 16 relies, then Gillman also does not anticipate dependent claim 16 and dependent claim 16 should be allowed

**Claims 33, 34, 36, 40, and 41**

With respect to claim 33, the Examiner cites paragraphs 26, 27, 30, 34, 35, 38, 41, 42, 44, 45, 46, 48, and 49 of Gillman as teaching the elements of claim 33. [Office Action, p. 7] In particular, the Examiner cites paragraphs 26, 27, and 30 as teaching the element of "receiving a project request from a buyer", paragraphs 34 and 35 as teaching the element of "distributing said project request according to type of manufacture to a selection of prospective manufacturers from among a plurality of available manufacturers", paragraphs 38, 41, 42, and 44 as teaching the element of "in response to receiving feasibility responses from said selection of prospective manufacturers", and paragraphs 45, 46, 48, and 49 as teaching the element of "facilitating feasibility of manufacture of said project request according to said plurality of feasibility responses, such that said project request is brokered for said buyer to facilitate obtaining a manufacturer for said project request." [Office Action, p. 7]

Applicants note that the Examiner objected to claim 35, which is dependent upon claim 33, as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to be clearly within the technological arts. [Office Action, p. 19] In particular, the Examiner notes that Gillman, the closest prior art of record, anticipates claim 33, but "does not disclose comparing the project request with a plurality of current project requests, etc." [Office Action, p. 19] In addition, the Examiner notes:

"the additional features recited in claim 35 are most nearly approached by the demand aggregation systems of Van Horn et al. (US Patent 6,604,089) disclose enabling buyers to submit project requests which other potential buyers are then informed of, for the purpose of obtaining bulk discounts (see col. 4, lines 1-21 and col. 9, lines 55-67). However, neither Gillman, Van Horn, nor any other prior art of record, discloses, teaches, or reasonably suggests comparing a buyer's

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project request with a plurality of current project requests; notifying the buyer if the project matches one of the plurality of current project requests; and, in response to receiving a buyer request for said one of said plurality of current project requests, facilitating said buyer in placing a specified order for said one of said plurality of current project requests.” [Office Action, pp. 19-20]

Applicants amend claim 33 to incorporate objected to claim 35. In addition, Applicants amend claim 33 to be clearly within the technological arts, as previously described with reference to the rejection under 35 USC 101. In particular, claim 33 currently reads:

33.(Currently Amended) A method for brokering project requests among a plurality of available manufacturers, said method comprising the steps of:

receiving a project request from a buyer;

processing, by a computer system, said project request so as to compare said project request with a plurality of current project requests;

responsive to detecting that said project request matches one of said plurality of current project requests, notifying said buyer that said project request matches one of said plurality of current project requests;

responsive to receiving a buyer request for said one of said plurality of current project requests, facilitating said buyer in placing a specified order for said one of said plurality of current project requests;

responsive to not detecting a match between one of said plurality of current project requests, distributing said project request according to type of manufacture to a selection of prospective manufacturers from among a plurality of available manufacturers; and

in response to receiving a plurality of feasibility responses from said selection of prospective manufacturers, processing, by a computer system, said plurality of feasibility responses so as to facilitate [facilitating] a determination of the feasibility of manufacture of said project request according to said plurality of

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feasibility responses, such that said project request is brokered for said buyer to facilitate obtaining a manufacturer for said project request.

Applicants note that Gillman does not teach the elements of “processing, by a computer system, said project request so as to compare said project request with a plurality of current project requests”, “responsive to detecting that said project request matches one of said plurality of current project requests, notifying said buyer that said project request matches one of said plurality of current project requests”, and “responsive to receiving a buyer request for said one of said plurality of current project requests, facilitating said buyer in placing a specified order for said one of said plurality of current project requests”. Thus, because Gillman does not teach each element of amended claim 33, Applicants respectfully request allowance of amended claim 33.

With respect to claims 34, 36, 40, and 41, the Examiner rejects these claims as anticipated by Gillman. Applicants respectfully propose that because Gillman no longer anticipates independent claim 33, upon which dependent claims 34, 36, 40, and 41 rely, then Gillman also does not anticipate dependent claims 34, 36, 40, and 41 and dependent claims 34, 36, 40, and 41 should be allowed

#### **Claims 43, 45, 49, and 50**

With respect to claim 43, the Examiner cites paragraphs 23-27, 30, 34, 35, 38, 41, 42, 44, 45, 46, 48, and 49 of Gillman as teaching the elements of claim 33. [Office Action, p. 8] In particular, the Examiner cites paragraphs 23-27 and Figure 1 as teaching “a broker server system communicatively connected to a network”, paragraphs 26, 27, and 30 as teaching the “means for receiving a project request at said broker server system from a buyer”, paragraphs 34 and 35 as teaching the “means for distributing said project request according to type of manufacture to a selection of prospective manufacturers from among a plurality of available manufacturers”, paragraphs 38, 41, 42, and 44 as teaching the element of “in response to receiving feasibility responses at said broker system from said selection of prospective manufacturers”, and

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paragraphs 45, 46, 48, and 49 as teaching the “means for facilitating feasibility of manufacture of said project request according to said plurality of feasibility responses.” [Office Action, p. 8]

Applicants note that the Examiner objected to claim 44, which is dependent upon claim 43, as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to be clearly within the technological arts. [Office Action, p. 20] In addition, the Examiner noted that “claim 44 is closely parallel to claim 35 and found to be potentially allowable on the same grounds.” [Office Action, p. 20]

Applicants amend claim 43 to incorporate claim 44 in the parallel manner to claim 33 amended to incorporate claim 35. In particular, as amended, Gillman does not teach all the elements of amended claim 43. Since amended claim 43 is closely parallel to amended claim 33, Applicants respectfully request allowance of amended claim 43 for the same reasons as amended claim 33 should be allowed.

With respect to claims 45, 49, and 50, the Examiner rejects these claims as anticipated by Gillman. Applicants respectfully propose that because Gillman no longer anticipates independent claim 43, upon which dependent claims 45, 49, and 50 rely, then Gillman also does not anticipate dependent claims 45, 49, and 50 and dependent claims 45, 49, and 50 should be allowed

*35 USC § 103(a)*

Applicants note the responsibility under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants note that all claims are commonly owned.

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**Claims 3-5 and 7-11**

Claims 3 and 11

Claims 3 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 1 and further in view of Thackston (U.S. Patent 6,295,513). [Office Action, p. 9] Applicants note the above proposition that amended claim 1 is not taught by Gillman and therefore as dependent claims of allowable subject matter, claims 3 and 11 should also be allowed.

Claim 4

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 1 and further in view of Ruffo et al. (U.S. Patent Application Publication 2001/0032166). [Office Action, p. 10] Applicants note the above proposition that amended claim 1 is not taught by Gillman and therefore as a dependent claim of allowable subject matter, claim 4 should also be allowed.

Claim 5

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 1 and further in view of Scolnik et al. (U.S. Patent Application Publication 2002/0007333). [Office Action, p. 11] Applicants note the above proposition that amended claim 1 is not taught by Gillman and therefore as a dependent claim of allowable subject matter, claim 5 should also be allowed.

Claim 7

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 1 and further in view of official notice. [Office Action, p. 11] Applicants note the above proposition that amended claim 1 is not taught by Gillman and therefore as a dependent claim of allowable subject matter, claim 7 should also be allowed. In addition,

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Applicants note that claim 7 is amended so that the official notice does not the elements of claim 7.

In particular, in the rejection of claim 7, the Examiner notes that Gillman “does not disclose receiving a suggestion for adjusting said project request to increase manufacturing feasibility, but official notice is taken that it is well known to receive such suggestions.” [Office Action, p. 11] As “official notice” the Examiner “recalls receiving suggestions when he, as a college or graduate student, took a project proposal to a machinist for custom manufacture.” [Office Action, pp. 11-12] Thus, the Examiner concludes that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to receive a suggestion for adjusting the project request to increase manufacturing feasibility, for the obvious advantage, from the manufacturer’s perspective, of being assured of the buyer’s consent to proposed modifications, and for the obvious advantage, from the buyer’s perspective, of being able to have a desired project manufactured, and of having it manufactured more easily, with concomitant reduced expense.” [Office Action, p. 12]

Applicants have amended claim 7 to read:

7. **(Currently Amended)** The method for procuring a manufacturer according to claim 1, said step of processing, by a computer system, said plurality of feasibility responses so as to select responding to said plurality of feasibility responses by selecting a manufacturer from among said plurality of prospective manufacturers, further comprising the steps [step] of:

receiving, in at least one of said plurality of feasibility responses, a suggestion for adjusting said specialized project request to increase manufacturing feasibility; and

processing, by said computer system, said suggestion so as to adjust said specialized project request when selecting said manufacturer.

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In establishing a prima facie case of obviousness under §103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully propose that the Examiner's example, cited as official notice, is merely a human step of interacting with a manufacturer to agree to how a product will be manufactured. The Examiner's example, cited as official notice, does not indicate teach a computer implemented step of receiving suggestions as part of a feasibility response and then processing the suggestion to adjust the specialized project request when the computer system selects a manufacturer. In contrast, claim 7 is amended to clarify that the suggestion is received with at least one of the plurality of feasibility responses and that a computer system processes the suggestion so as to adjust the specialized project request when selecting the manufacturer. Thus, where Gillman in view of the official notice of the Examiner no longer teaches all the elements of amended claim 7, amended claim 7 is no longer obvious and Applicants respectfully request allowance of amended claim 7.

#### Claim 8

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 1 and further in view of the article "Class Action Suit Filed Against StorMedia, Inc. and Its Officers and Directors Alleging Misrepresentation and Insider Trading" hereinafter referred to as "Class Action Suit". [Office Action, p. 12] Applicants note the above proposition that amended claim 1 is not taught by Gillman and therefore as a dependent claim of allowable subject matter, claim 8 should also be allowed. In addition, Applicants note that claim 8 is not obvious in view of Gillman and further in view of the article "Class Action Suit".

In particular, in the rejection of claim 8, the Examiner notes that Gillman "does not disclose receiving a project request cancellation due to lack of manufacturing feasibility, but it is well known to cancel a project request due to lack of manufacturing feasibility, as taught by "Class Action Suit" (paragraph beginning "the complaint charges"). Thus, the Examiner concludes that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the step of receiving a plurality of feasibility

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responses for a project request to comprise receiving a project request cancellation due to lack of manufacturing feasibility, as an obvious consequence of the inability of some manufacturers, on occasion to manufacture desired products, or their judgment that doing so would not be feasible.” [Office Action, p. 12]

Claim 8 currently reads:

8. (Original) The method for procuring a manufacturer according to claim 1, said step of receiving a plurality of feasibility responses for said project request further comprising the step of:

receiving a project request cancellation due to lack of manufacturing feasibility.

In establishing a prima facie case of obviousness under §103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). “Class Action Suit” is an article describing the charges in a complaint filed as a class action suit. The reference describes that StorMedia “cancelled the attempted stock offering, supposedly due to “market conditions”. Further, the reference describes that StorMedia’s contract with Maxtor had been cancelled, apparently due to StorMedia’s inability to successfully manufacture and deliver disks. Thus, Applicants respectfully assert that the reference merely describes the cancellation of promises already made, after the fact, independent of any application to a computer system controlling the receipt of the cancellation of the promises already made. In contrast, claim 8 teaches a project request cancellation, where a project request is a proposal for a project, on which manufacturers may bid. A project request cancellation occurs when there are not any manufacturers for whom it is feasible to produce the project request. Thus, where “Class Action Suit” teaches post bid cancellation and not a pre bid cancellation due to a lack of bids, “Class Action Suit” does not teach all the elements of claim 8. Therefore, where the Office Action fails to establish prima facie obviousness, Applicants respectfully request withdrawal of the rejection and allowance of claim 8.

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Second, in establishing prima facie obviousness under §103(a), the references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ 1438 (Fed. Cir. 1991). Applicants note that Gillman is a published patent application that teaches an automated reverse bidding auction process. In contrast, "Class Action Suit" is an article that explains the complaints against a corporation that misrepresented the company, cancelled stock offerings, and were unable to manufacture and deliver on contracts. There is no suggestion in "Class Action Suit" that it is part of the art of "electronic commerce" nor is there a suggestion in Gillman to combine with a teaching by a reference that post-bid cancellation may occur. Thus, Applicants respectfully assert that when considered as a whole, the references are insufficient in any suggestion of the desirability, and thus obviousness of making the combination. Therefore, where the Office Action fails to establish prima facie obviousness, Applicants respectfully request withdrawal of the rejection and allowance of claim 8.

Claims 9 and 10

Claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 1 and further in view of Posner (U.S. Patent Application Publication 2003/0208434). [Office Action, p. 13] Applicants note the above proposition that amended claim 1 is not taught by Gillman and therefore as dependent claims of allowable subject matter, claims 9 and 10 should also be allowed.

**Claims 13-15 and 17-21**

In rejecting claims 13-15 and 17-21, the Examiner notes that claim 13 is essentially parallel to claim 3, claim 14 is essentially parallel to claim 4, claim 15 is essentially parallel to claim 5, claim 17 is essentially parallel to claim 7, claim 18 is essentially parallel to claim 8,

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claim 19 is essentially parallel to claim 9, claim 20 is essentially parallel to claim 10, and claim 21 is essentially parallel to claim 11. [Office Action, p. 14] Thus, the Examiner rejects claims 13-15 and 17-21 under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 12 and further in view of Thackston, Ruffo, Scolnik, official notice, "Class Action Suit", Posner, Posner, and Thackston, respectively, for the reasons previous set forth. [Office Action, p. 14]

Applicants respectfully request allowance of claims 13-15 and 17-21 as dependent claims of an independent base claim 12, amended for allowance. In addition, Applicants respectfully request allowance of claims 13-15 and 17-21 for the same reasons previously specified with respect to parallel claims 3-5 and 7-11. In particular, Applicants note that claim 17 is amended in a similar manner as claim 7.

#### Claims 22-32

In rejecting claims 22, 23, and 27, the Examiner notes that claims 22, 23, and 27 are essentially parallel to claims 1, 2, and 6, respectively and rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman on essentially the same grounds. [Office Action, p. 14] Applicants respectfully note that claim 22 is amended in a similar manner as claim 1, where claim 1 is amended for allowance. Thus, Applicants respectfully request allowance of amended claim 22 for the same reasons as amended claim 1 should be allowed. In addition, Applicants respectfully request allowance of dependent claims 23 and 27, which are dependent on a based claim 22 amended for allowance.

Further, in rejecting claims 24-26 and 28-32, the Examiner notes that claims 24, 25, 26, 28, 29, 30, 31, and 32 are closely parallel to claims 3, 4, 5, 7, 8, 9, 10, and 11, respectively, and therefore are rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 22 above, and further in view of Thackston, Ruffo, Scolnik, official notice, "Class Action Suit", Posner, Posner, and Thackston, respectively, for the reasons previous set forth. [Office Action, p. 15] Applicants respectfully request allowance of claims 24-26 and 28-32 as dependent claims of an independent base claim 22, amended for allowance. In addition,

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Applicants respectfully request allowance of claims 24-26 and 28-32 for the same reasons as previously specified with respect to parallel claims 3-5 and 7-11.

**Claims 37-39 and 42**

Claim 37

Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 33 and further in view of Van Horn et al. (U.S. Patent 6,604,089). [Office Action, p. 15] Applicants note the above proposition that amended claim 33 is not taught by Gillman and therefore as a dependent claim of allowable subject matter, claim 37 should also be allowed.

Claim 38

Claim 38 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 33 and further in view of Posner (U.S. Patent Application Publication 2003/0208434). [Office Action, p. 16] Applicants note the above proposition that amended claim 33 is not taught by Gillman and therefore as a dependent claim of allowable subject matter, claim 38 should also be allowed.

Claims 39 and 42

Claims 39 and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied to claim 33 and further in view of official notice. [Office Action, pp. 17, 18] Applicants note the above proposition that amended claim 33 is not taught by Gillman and therefore as a dependent claim of allowable subject matter, claims 39 and 42 should also be allowed.

**Claims 46-48 and 51**

In rejecting claims 46-48 and 51, the Examiner notes that claims 46-48 and 51 are essentially parallel to claims 37-39 and 42, respectively and rejected under 35 U.S.C. §103(a) as

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being unpatentable over Gillman as applied to claim 43, and further in view of Van Horn, Posner, official notice, and official notice. [Office Action, p. 18]

Applicants respectfully request allowance of claims 46-48 and 51 as dependent claims of an independent base claim 43, amended for allowance. In addition, Applicants respectfully request allowance of claims 46-48 and 51 for the same reasons as previously specified with respect to parallel claims 37-39 and 42.

#### **Claims 52-53 and 56-61**

In rejecting claims 52, 53, 55, 59, and 60, the Examiner notes that claims 52, 53, 55, 59, and 60 are essentially parallel to claims 33, 34, 36, 40, and 41, respectively and therefore are rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman on essentially the same grounds [Office Action, p. 18] First, Applicants respectfully request allowance of independent claim 52 which is amended to incorporate objected to claim 52 in a similar manner as amended independent claim 33. Next, Applicants respectfully request allowance of claims 53, 55, 59, and 60 as dependent claims of an independent base claim 52, amended for allowance. In addition, Applicants respectfully request allowance of claims 52, 53, 55, 59, and 60 for the same reasons as previously specified with respect to parallel claims 33, 34, 36, 40, and 41.

In addition, in rejecting claims 56, 57, 58, and 61, the Examiner notes that claims 56, 57, 58, and 61 are essentially parallel to claims 37, 38, 39, and 42, respectively and therefore are rejected under 35 U.S.C. §103(a) as being unpatentable over Gillman as applied in claim 52 and further in view of Van Horn, Posner, official notice, and official notice, respectively. [Office Action, p. 19] First, Applicants respectfully request allowance of claims 56, 57, 58, and 61 as dependent claims of an independent base claim 52, amended for allowance. In addition, Applicants respectfully request allowance of claims 56, 57, 58, and 61 for the same reasons as previously specified with respect to parallel claims 37, 38, 39, and 42.

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*Allowable Subject Matter*


Applicants note the objections to claims 35, 44, and 54, as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. [Office Action, pp. 19, 20] As previously discussed, Applicants amend the rejected base claims 33, 43, and 52, upon which claims 35, 44, and 54 were dependent, to incorporate the teachings of claims 35, 44, and 54 and cancel claims 35, 44, and 54.

*Conclusion*

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections and the allowance of the current pending claims. If the Examiner feels that the pending claims could be allowed with minor changes, Applicants invite the Examiner to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted.

 on 11/30/2004

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